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09/926,720	12/06/2001	Kenji Sato	011581	6454

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EXAMINER

KANG, INSUN

ART UNIT

PAPER NUMBER

2124

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/926,720	SATO, KENJI	
	Examiner	Art Unit	
	Insun Kang	2124	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 4/27/2004, 4/20/2004, and 12/6/2001.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☒ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/27/04, 4/20/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responding to application papers dated 4/27/2004, 4/20/2004, and 12/6/2001.
2. Claims 1-21 are pending in the application.

### ***Drawings***

3. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: '7' in Fig 2. and S27 in Fig. 3. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to

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obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

5. The disclosure is objected to because of the following informalities: there appears to be a minor error in spacing between words throughout the specification: for example, see claim 1, line 5. Appropriate correction is required.

### ***Claim Objections***

6. Claim 19 is objected to because of the following informalities: there appears to be a minor typographical error in line 6: 'e' needs to be added to "xecuting." Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims recite an information setting, which is changeable by a user, and

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another information setting, which is unchangeable by the user, and more specifically the claims recite that age-related information setting is unchangeable by the user and execution time-related information setting is changeable by the user. The specification does not describe these limitations. In the specification, the settings are (1) current date and time, (2) date of birth of a user using game software

(3) Daily time restriction for using game software

(4) Time restriction on continuous use of game software

(5) Time period during which game software use is prohibited

(6) Emotional maturity of a user using game software

In pages 9- 11, the specification recites, (1) cannot be changed by a user (page 9 last paragraph), "the information settings of (1)-(6) can be arbitrarily changed by the seller of a software execution criteria device (page 11 lines 8-12)," the "information settings of (3)-(6) can be arbitrarily changed by the purchaser (page 11)," and the "information setting of (2) can be set only one time by the purchaser of a software execution criteria device (page 11)." The specification does not recite that the user can change the execution time-related information setting. Furthermore, (2) is not changeable once the birthday information is set/entered. However, the specification also contradictorily recites, "a game software cannot change the information settings of (2)-(6) without the permission of the purchaser of ... device (page 11 last paragraph)" and a "purchaser of the software execution criteria device 5 can change the information settings of (2)-(6) (page 12 first paragraph)." As shown above, the claims are not enabling because of the

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disagreement between the specification and the claims and the contradictory description.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-4, 8-19, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Morishita et al. (US Patent 5,968,175) hereinafter referred to as "Morishita."

Per claim 8:

Morishita discloses:

-accessing information settings which have been previously set and relate to criteria for judging propriety of software execution ("A software use method control system including a storage device and an access controller. The storage device stores

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information for designating a right to access system resources of operating systems which are to be executed in the software use method control system," abstract)  
-judging whether software may be executed based on said information settings ("a program-execution inhibiting device for determining whether the program-executing device is allowed to execute the program, from the execution request which the input receiver has received," abstract)

-executing said software only when it is judged that the software may be executed ("a program-execution inhibiting device for determining whether the program-executing device is allowed to execute the program, from the execution request which the input receiver has received, and for inhibiting the program executing device from executing the programs when the programs are not allowed to be executed," abstract)

-wherein said information settings includes an information setting which is changeable by a user and another information setting which is unchangeable by the user ("If the user is the author of the software, the additional information is changed and written to the additional information generating table via the copyright control section ... If the user is not the author of the software, the additional information cannot be changed," col. 47 lines 1-13) as claimed.

Per claim 9:

The rejection of claim 8 is incorporated, and further, Morishita teaches:

wherein said information setting includes a user-specific information setting which is set individually for each user, so that the judgment results from said step of judging can

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differ depending on individual users even when the individual users try to execute the same software under the same conditions(col. 4 lines 36-65) as claimed.

Per claims 1-2, they are the computer apparatus versions of claims 8 and 9, respectively, and are rejected for the same reasons set forth in connection with the rejection of claims 8 and 9 above.

Per claim 3:

The rejection of claim 1 is incorporated, and further, Morishita teaches:

-said information settings include an age-related information setting relating to the age of a user, so that, when the user tries to execute age-restricted software, said software execution judging means judges that said age-restricted software may be executed in a case that the age of the user is not subject to execution restriction based on said age-related information setting; wherein said age-related information setting is unchangeable by the user (col. 49 section Main components and features) as claimed.

Per claim 4:

The rejection of claim 1 is incorporated, and further, Morishita teaches:

- said information settings include an execution time-related information setting for restricting execution time, so that, when a user tries to execute software, said software execution judging means judges that said software may be executed in a case that the current temporal condition is not subject to execution restriction based on said execution time-related information setting; wherein said execution time-related information setting is changeable by the user (col. 58 Lines 40-50) as claimed.



Per claim 15:

Morishita discloses:

- setting memorizing means for memorizing information settings relating to criteria for judging propriety of software execution, software execution judging means for judging whether or not software may be executed based on said information settings memorized in said setting memorizing means; ("A software use method control system including a storage device and an access controller. The storage device stores information for designating a right to access system resources of operating systems which are to be executed in the software use method control system," abstract; "a program-execution inhibiting device for determining whether the program-executing device is allowed to execute the program, from the execution request which the input receiver has received," abstract)

and software executing means for executing said software only when said software execution judging means judges that said software may be executed user ("a program-execution inhibiting device for determining whether the program-executing device is allowed to execute the program, from the execution request which the input receiver has received, and for inhibiting the program executing device from executing the programs when the programs are not allowed to be executed," abstract)

wherein said information settings includes a changeable information setting which is changeable by a user and a unchangeable information setting which is unchangeable by the user ("If the user is the author of the software, the additional information is changed and written to the additional information generating table via the copyright

control section ... If the user is not the author of the software, the additional information cannot be changed," col. 47 lines 1-13); wherein said changeable information setting includes a cumulative execution time setting for determining a limit of cumulative execution time in a predetermined time period; wherein said software execution judging means judges that said software may be executed only when the cumulative execution time in the predetermined time is shorter than said limit (col. 58 Lines 40-50) as claimed.

Per claim 14, it is the apparatus version of claim 4, respectively, and is rejected for the same reasons set forth in connection with the rejection of claim 4 above.

Per claim 16, it is the method version of claim 14, respectively, and is rejected for the same reasons set forth in connection with the rejection of claim 14 above.

Per claim 17, it is the method version of claim 15, respectively, and is rejected for the same reasons set forth in connection with the rejection of claim 15 above.

Per claims 10 and 11, these claims are another versions of the claimed method discussed in claims 2 and 6, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth the above.

Per claims 12 and 13, they are the product versions of claims 8 and 9, respectively, and are rejected for the same reasons set forth in connection with the rejection of claims 8 and 9 above.

Per claim 18, this claim is another version of the claimed method discussed in claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth the above.

Per claim 19, this claim is another version of the claimed method discussed in claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth the above.

Per claim 21, this claim is another version of the claimed method discussed in claim 8, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth the above.

11. Claims 1, 2, 5-13, and 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Makoto (JP 09-292989).

Per claim 8:

Makoto discloses:

-accessing information settings which have been previously set and relate to criteria for judging propriety of software execution ("the starting control information of each application program stored in an application program information storing means...with each other and an application starting judging means...judges the propriety of the starting of the application program," abstract)

-executing said software only when it is judged that the software may be executed ("Based on the judgment of the application starting judging means...an application starting control means...to control starting of an application program is included," page 2 paragraph 0016)

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-wherein said information settings includes an information setting which is changeable by a user and another information setting which is unchangeable by the user (paragraph 0023, 0035; 0016) as claimed.

Per claim 9:

The rejection of claim 8 is incorporated, and further, Makoto teaches:

wherein said information setting includes a user-specific information setting which is set individually for each user, so that the judgment results from said step of judging can differ depending on individual users even when the individual users try to execute the same software under the same conditions(paragraph 0016) as claimed.

Per claims 1-2, they are the computer apparatus versions of claims 8 and 9, respectively, and are rejected for the same reasons set forth in connection with the rejection of claims 8 and 9 above.

Per claim 5:

The rejection of claim 1 is incorporated, and further, Makoto teaches:

-said software execution judging means judges if said software may be executed without restriction, or may be executed with a certain restriction, or may not be executed; and wherein, when said software execution judging means judges that said software may be executed with the certain restriction, said software execution means executes said software in concord with the certain restriction ("Based on the judgment of the application starting judging means...an application starting control means...to

control starting of an application program is included," page 2 paragraph 0016) as claimed.

Per claim 6:

The rejection of claim 1 is incorporated, and further, Makoto teaches:

-a software execution criteria device which is removably mounted to or disconnectably communicably connected to said computer apparatus, wherein said setting memorizing means is incorporated in said software execution criteria device (paragraph 0016) as claimed.

Per claim 7:

The rejection of claim 6 is incorporated, and further, Makoto teaches:

- said software execution judging means judges whether or not software may be executed based also on whether or not said software execution criteria device is mounted to or connected to said computer apparatus (paragraph 0016) as claimed.

Per claims 10 and 11, these claims are another versions of the claimed method discussed in claims 2 and 6, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth the above.

Per claims 12 and 13, they are the product versions of claims 8 and 9, respectively, and are rejected for the same reasons set forth in connection with the rejection of claims 8 and 9 above.

Per claim 18, this claim is another version of the claimed method discussed in claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth the above.

Per claim 19, this claim is another version of the claimed method discussed in claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth the above.

Per claim 20, this claim is another version of the claimed method discussed in claim 6, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth the above.

Per claim 21, this claim is another version of the claimed method discussed in claim 8, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth the above.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Insun Kang whose telephone number is 703-305-6465. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on 703-305-9662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IK  
9/16/2004



ANIL KHATRI  
PRIMARY EXAMINER